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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/653,609	09/02/2003	Brian Jay Vondruska	201PP029A	3691

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LEGAL DEPARTMENT
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EXAMINER	
SILVERMAN, ERIC E	
ART UNIT	**PAPER NUMBER**
1615	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/653,609	VONDRUSKA, BRIAN JAY	
	Examiner	Art Unit	
	Eric E. Silverman, PhD	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 December 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) *12-26* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *3-4-04, 12-4-03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 1 – 26 are pending in this action.

Election/Restrictions

Applicant's election of Group I and the species of a CARBOPOL rheology modifier and ULTRASIL complexing agent (note that common trade names for the elected species are being used in this office action instead of the generic names) in the reply filed on 12/21/2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without traverse** (MPEP § 818.03(a)).

Claims 12 – 26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Specification

The use of the trademarks CARBOPOL and ULTRASIL, among others, has been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Double Patenting

Claims 1 – 11 of this application conflict with claims 1 – 13 of Application No. 10/792,993. 37 CFR 1.78(b) provides that when two or more applications filed by the

same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1 – 11 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 – 13 of copending Application No. 10/792,993. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for complexing agents comprising bulky (understood

in the context of the claims to mean sterically hindered) polymers with molecular weights over 1,000, does not reasonably provide enablement for other bulky complexing agents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims.

Enablement is considered in view of the Wands factors (MPEP 2164.01 (A)). These include: nature of the invention, breadth of the claims, guidance of the specification, the existence of working examples, state of the art, predictability of the art and the amount of experimentation necessary. All of the Wands factors have been considered with regard to the instant claims, with the most relevant factors discussed below.

Nature of the invention: The instant claims recite a method of compatibilizing an anionic rheology modifier with cationic materials by complexing the cationic materials with an anionic complexing agent. The claims require that the anionic complexing agent to contain a bulky material

State of the prior art: The prior art recognizes the difficulty of such combinations. For example, the two Polotti et al references (see form PTO-1449 filed 12/4/2003) recognize that addition of cationic materials to anionic rheology modifiers, such as Carbopol, may negate the effects of these materials. Some way of overcoming this problem are also known. The art recognizes that use of moderate to high molecular weight cationic agents that are bulky is a solution (see Carbopol thickeners, Pemulen emulsifiers and GoodRite K 700 Dispersants hereafter "Carbopol reference", of record).

Note particularly that the art requires that the agent be both sterically hindered (bulky) and moderate to high molecular weight.

Existence of working examples/specification: The specification discloses examples of moderate to high molecular weight complexing agents. Applicant also does not take into account in the specification or through working examples that not all bulky agents have moderate to high molecular weight, and thus, according to the evidence of record, are not enabled for the practice of this invention. For example, the artisan would recognize that t-butyl acetate is a bulky material, but according to the Carbopol reference, it is not certain that this material would be useful in the invention.

Amount of experimentation necessary: With low molecular weight, bulky agents, the artisan has no guidance as to how to proceed with the process of this invention. The artisan would have to essentially start from scratch, testing each and every low molecular weight bulky agent to determine if and how it could be compatiblized. Also, compatibility is likely to depend on the nature of the anionic rheology modifier. Thus, each permutation of anionic rheology modifier, bulky complexing agent, and cationic material, would have to be tested separately to determine the compatibility of the particular combination.

It would require undo experimentation for one of skill in the art to practice the claimed invention. Therefore, the claimed invention of a method compatiblizing anionic rheology modifiers with cationic materials is not fully enabled by the instant specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 5, and 8 – 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Carbopol thickeners, Pemulen emulsifiers and GoodRite K 700 Dispersants (hereafter "Carbopol reference", of record).

The Carbopol reference teaches formulating carbopol (the elected polymeric rheology modifier) with cationic materials by adding alkylamine polyglycolether sulfate. The alkylamine polyglycolether sulfate contains has anionic component (the sulfate), and contains a bulky, polymeric material (the polymer). Mixing of the alkylamine polyglycolether sulfate with the cationic material is understood to meet the step of "complexing", as required by claim 1, since cationic groups and anionic groups inherently form complexes when mixed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 – 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,332,762 to Maschberger et al.

Maschberger teaches a method of making a homogeneous ("compatible") polymeric composition comprising Ultrasil (col. 9, lines 45 – 48 and col. 11, lines 22 – 29). Carbopol is a suggested additive, used as a thickener (that is, a rheology modifying agent) (col. 4, lines 40 – 50). These elements comprise the elected species of instant claims – combining them amounts to the method of instant invention.

Maschberger does not require Carbopol to be added to the composition.

It would be prime facie obvious to a person of ordinary skill in the art at the time of the invention to add Carbopol, since the addition of same is suggested by the art. The artisan would thus be following the explicit suggestion of the art, and would enjoy a reasonable expectation of success.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 7,153,496 is noted for its teachings of compatible rheology modifying polymers (examples).

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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